

REMARKS

Claims 1-36 are pending in the application.

In response to the Examiner's inquiry, Applicant notes that all of the claims were owned by the same entity at the time of the invention.

Claims 1-6, 10, 12 and 15 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Pub. No. 2002/0015825 to Meco et al. ("Meco") in view of U.S. Patent No. 7,396,884 to Achten ("Achten"). This rejection is respectfully traversed as follows.

Neither Meco nor Achten teaches or suggests a toothed belt adapted to operate in direct contact with oil or partially immersed in oil, as recited in independent claim 1. Rather, the belts disclosed in Meco and Achten are belts that operate in dry conditions.

Moreover, Achten teaches away from the present invention because the use of HNBR together with resorcinol formaldehyde ("RFL") resin disclosed therein would not be well-suited for operation of a belt in oil. This is because RFL is an adhesive composition, and oil is aggressive against resorcin and formaldehyde and similar adhesive systems. Achten also teaches a range of HNBR of 10% to 50%, but using an HNBR percentage below 33% could not provide a belt capable of resisting the duration tests in oil.

Finally, Applicants respectfully submit that the claimed toothed belt satisfies a long-felt need for a toothed belt capable of operating effectively for its lifetime in contact with oil, for example, in drive system applications. While many drive systems use gears or chains, it would be desirable to substitute toothed belts because of the greater meshing precision they provide. However, a toothed belt suitable for such a system would have to operate effectively in contact with oil because of the oil present in most drive systems. Before the present invention, to Applicant's knowledge, none of the proposed toothed belts were able to resist the duration tests, and therefore there have not been toothed belts in the automotive market. The toothed belts of the present invention were duration tested and resisted at least 80,000,000 cycles. *See* Published Application at paragraphs 59-60.

For at least the above-stated reasons, it is respectfully submitted that independent claim 1 and the claims that depend therefrom are patentable over Meco in view of Achten.

Claims 11, 13 and 14 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Meco and Achten in view of U.S. Patent No. 6,945,891 to Knutson et al. ("Knutson").

Claims 11, 13 and 14 depend either directly or indirectly from independent claim 1, which is believed patentable over Meco and Achten, as discussed above. It is respectfully submitted that Knutson does not make up for the deficiencies of Meco and Achten.

Claims 16-21, 25, 27, 30 and 31 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Meco and Achten in view of U.S. Patent No. 5,967,922 to Ullein at al. ("Ullein"). This rejection is respectfully traversed as follows. Neither Meco nor Achten teaches or suggests a toothed belt for maintaining use in oil-wet condition, as recited in independent claim 16. Rather, the belts disclosed in Meco and Achten are belts that operate in dry conditions. It is respectfully submitted that Ullein does not make up for the deficiencies of Meco and Achten. Accordingly, independent claim 16 and the claims that depend therefrom are believed patentable over Meco and Achten in view of Ullein.

Claims 22-24 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Meco, Achten and Ullein in view of U.S. Patent No. 7,506,249 to Osaka at al. ("Osaka"). This rejection is respectfully traversed as follows. Claims 22-24 depend either directly or indirectly from independent claim 16. As discussed in detail above, independent claim 16 and the claims that depend therefrom are believed patentable over Meco, Achten and Ullein. It is respectfully submitted that Osaka does not make up for the deficiencies of Meco, Achten and Ullein.

Claims 26, 28 and 29 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Meco, Achten and Ullein in view of Knutson. Claims 26, 28 and 29 depend either directly or indirectly from independent claim 16. As discussed in detail above, independent claim 16 and the claims that depend therefrom are believed patentable over Meco, Achten and Ullein. It is respectfully submitted that Knutson does not make up for the deficiencies of Meco, Achten and Ullein.

New independent claim 32 recited an oil-resistant toothed belt, and new independent claim 36 recites a toothed belt adapted to operate in direct contact with oil or partially immersed in oil. It is believed new independent claims 32 and 36 and the claims that depend therefrom are patentable over the cited references for at least the same reasons discussed above with reference to independent claims 1 and 16.

The Commissioner is authorized to charge any additional fee required, or credit any overpayment, to our Deposit Account No. 50-2298, in the name of Luce, Forward, Hamilton & Scripps LLP.

Respectfully submitted,

May 26, 2009
Date

Eric L. Lane
Eric L. Lane
Attorney for Applicant(s)
Reg. No. 56,399
c/o LUCE, FORWARD, HAMILTON
& SCRIPPS LLP
11988 El Camino Real, Ste. 200
San Diego, California 92130
Telephone No.: (858) 720-6300

701032646.1